

REMARKS

Claims 1-5, 7, 9-22 and 24 are pending in the present application. In a Final Office Action mailed April 1, 2004, the Examiner rejected all pending claims. On September 27, 2004, Applicant filed a Notice of Appeal, a Petition for Extension of Time under 37 CFR 1.136(a), and a check for the extension fee. Subsequently, Applicant noticed that the Amendment and Response filed December 4, 2003 did not fully address the Examiner's Objections to the drawings. Applicant submits herein a Request for Continued Examination under 37 CFR 1.114, including a submission consisting of a drawing amendment and arguments which Applicant now assert patentably distinguish the invention over the cited prior art. Applicant understands that under 37 CFR 1.114 this RCE will constitute a request to withdraw the appeal and to re-open prosecution of the application before the examiner.

1. NON-PRIOR ART MATTERS

(a) The Office Action objected to the drawings as failing to comply with 37 CFR 1.85(p)(5) because they did not include the reference sign '54'.

A proposed drawing amendment is enclosed.

(b) The Office Action rejected claims 1-5, 7, 9, and 24 under 35 USC 103(a) as being unpatentable over Ginsburg in view of Gerson. Applicant respectfully traverses the rejection.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.¹ If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness.²

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references

¹MPEP Sec. 2142.

² Id.

themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.³

Applicant respectfully traverses the § 103 rejection because the office action has not established a *prima facie* case of obviousness.

The reference does not teach or suggest all the claim limitations.

As to amended claim 1, the references do not teach or suggest:

An apparatus for adjusting a die of a printing press, comprising: a chase defining a vertical axis and a horizontal axis, a die frame slidably secured to the chase to allow adjustment of the die frame in the vertical axis and the horizontal axis of the chase; at least one of a coarse vertical adjustment and a coarse horizontal adjustment; and at least one of a fine vertical adjustment and a fine horizontal adjustment the fine vertical adjustment and fine horizontal adjustment operating to adjust the die frame in the vertical axis of the chase and the horizontal adjustment operating to adjust the die frame in the horizontal axis of the chase.

The Office action states that

"Gerson teaches an apparatus for precisely positioning a template on a substrate, including: an apparatus for adjusting a die comprising: a vertical axis and a horizontal axis; a frame (36, Fig. 1) slidably secured to the chase to allow the adjustment of the frame in the vertical axis and the horizontal axis; at least one of a coarse vertical adjustment ("coarse adjustment in vertical displacement", col. 3, lines 39-40) and a coarse horizontal adjustment ("approximate or coarse adjustment", col. 4, lines 7-8); and at least one of a fine vertical adjustment and a fine horizontal adjustment ("precise selection of fine space intervals both vertically and horizontally", col. 1, lines 55-56).

³Id. (emphasis supplied)

This is incorrect. Item 36 of Gerson is not a "frame" but a "chase" (col. 2 l. 70). Since 36 is a chase, there is no "frame slidably secured to the chase." Gerson discloses at most the adjustment of the chase 36 along the rack 80. Furthermore, col. 1 lines 51-56 refer to "adjustable positioning of the negative carrier support." The "negative carrier support" is item 22, which supports the negative carrier 36, which is also the chase. There is thus also no disclosure of the fine vertical adjustment and fine horizontal adjustment operating to adjust the die frame in the vertical axis of the chase and the horizontal adjustment operating to adjust the die frame in the horizontal axis of the chase. It is the chase itself that is adjusted, not the die frame relative to the chase.

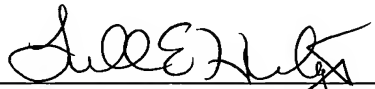
Amended claim 1 is therefore allowable.

CONCLUSION

In view of Applicant's remarks, the claims are believed to be in condition for allowance. Reconsideration, withdrawal of the rejections, and passage of the case to issue is respectfully requested.

Respectfully submitted,

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